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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,887	12/21/2001	Keith Alexander Harrison	30003064-2	5605

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

WILLIAMS, JEFFERY L

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/023,887	HARRISON, KEITH ALEXANDER	
	Examiner	Art Unit	
	Jeffery Williams	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This action is in response to the communication filed on 2/21/06.

All objections and rejections not set forth below have been withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/21/06 has been entered.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 1, 15, 16, 17, 31, 32, 33, 45, and 46 each contain the limitation (or essentially similar) comprising: *storing a secret in memory of the personal*

1 *communication device prior to a user of the personal communication device acquiring*
2 *the personal communication device* [emphasis added]. The specification does not
3 provide support for this limitation within these claims.
4

5 ***Claim Rejections - 35 USC § 112***
6

7 The following is a quotation of the first paragraph of 35 U.S.C. 112:

8 The specification shall contain a written description of the invention, and of the manner and process of
9 making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
10 art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
11 set forth the best mode contemplated by the inventor of carrying out his invention.
12

13
14 Claims 1, 15, 16, 17, 31, 32, 33, 45, and 46 are rejected under 35 U.S.C. 112,
15 first paragraph, as failing to comply with the written description requirement. The
16 claim(s) contains subject matter which was not described in the specification in such a
17 way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the
18 time the application was filed, had possession of the claimed invention. See above
19 objection to the specification.
20

21 ***Claim Rejections - 35 USC § 103***
22

23 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
24 obviousness rejections set forth in this Office action:

25 (a) A patent may not be obtained though the invention is not identically disclosed or described as set
26 forth in section 102 of this title, if the differences between the subject matter sought to be patented and
27 the prior art are such that the subject matter as a whole would have been obvious at the time the

1 invention was made to a person having ordinary skill in the art to which said subject matter pertains.
2 Patentability shall not be negated by the manner in which the invention was made.
3
4
5

6 **Claims 1 – 10, 13 – 26, 29 – 42, 45, and 46 are rejected under 35 U.S.C.**

7 **103(a) as being unpatentable over Khello, “Method and Apparatus for User**
8 **Authentication”, U.S. Patent 5,724,423. in view of Tuneld et al., “Mobile Telephone**
9 **Auto PC Logon”, WO 00/31608.**

10
11
12 Regarding claim 17, Khello discloses:

13 *a personal communication device, the personal communication device*
14 *comprising a memory in which is stored a secret (Khello, fig. 3; elems. 29, 34; col. 2,*
15 *line 63 – col. 3, line 11; col. 8, lines 27-46). Khello discloses the use of memory to store*
16 *secrets such as a user PIN, encoding keys, and secret encoding algorithms.*

17 *and a digital device capable of communication with the personal communication*
18 *device (Khello, fig. 4),*

19 *the personal communication device being configured whereby upon the digital*
20 *device requesting a secret from the personal communication device, the personal*
21 *communication device requests confirmation from a user that the secret can be*
22 *provided and provides the secret to the digital device only if the confirmation is provided*
23 *by the user (Khello, col. 1, lines 26-32; col. 6, lines 5-30).*

24 Khello does not disclose that a secret is stored prior to a user of the personal
25 communication device acquiring the personal communication device.

1 Tuneld discloses that secrets can be stored a memory prior to a user acquiring a
2 personal communication device in which the memory is placed (Tuneld, pg. 1, lines 18-
3 21; pg. 2, lines 15-24; pg. 4, lines 14-18). Thus, additional security is achieved over the
4 system of Khello, as the communication device also is able to serve as an avenue of
5 user verification.

6 It would have been obvious to one of ordinary skill in the art to employ the
7 teachings of Tuneld within the system of Khello. This would have been obvious
8 because one of ordinary skill in the art would have been motivated to enhance system
9 security by preventing unauthorized users from operating the communication device.

10

11 Regarding claim 18, the combination of Khello and Tuneld discloses:

12 *in which the communication capable of being established between the personal*
13 *communication device and the digital device is wireless communication* (Khello, col. 5,
14 lines 46 – 65). Khello discloses that users may access services using a portable
15 radiotelephone.

16

17 Regarding claim 19, the combination of Khello and Tuneld discloses:

18 *in which the secret is encrypted in the memory and the digital device is capable*
19 *of decrypting the secret* (Khello, col. 6, lines 20-30, 47-67; col. 7, lines 17-36).

20

21 Regarding claim 20, the combination of Khello and Tuneld discloses:

1 *in which the secret is encrypted according to a key provided by the digital device*
2 *and in which the encrypted secret is not transmitted out to the digital device until an*
3 *appropriate password is provided by the user to the personal communication device, at*
4 *which time the encrypted secret is output to the digital device by way of the personal*
5 *communication device* (Khello, col. 7, lines 17-36; col. 8, lines 27-55; Abstract, lines 12-
6 14). The combination of Khello and Tuneld discloses that the user authentication
7 service provides the personal communication device with a program for analogously
8 deriving the identical key (thus providing a key) as well as secret encryption algorithms
9 for encrypting the PIN. Furthermore, herein, the combination of Khello and Tuneld
10 show that the user provides an appropriate secret before an output by the personal
11 communication device.

12

13 Regarding claim 21, the combination of Khello and Tuneld discloses:

14 *in which the confirmation comprises the user providing a secret* (Khello, col. 6,
15 lines 20-30).

16

17 Regarding claim 22, the combination of Khello and Tuneld discloses:

18 *in which to request the secret, the digital device is configured to establish contact*
19 *with the personal communication device and the personal communication device is*
20 *configured to indicate to the user that a request for a secret has been received* (Khello,
21 col. 5, line 57 – col. 8, line 30).

22

1 Regarding claims 23 and 24, the combination of Khello and Tuneld discloses:
2 *in which the indication comprises providing an audible signal and in which the*
3 *indication comprises providing a visual signal* (Khello, col. 6, lines 20-30).

4
5 Regarding claim 25, the combination of Khello and Tuneld discloses:
6 *in which the personal communication device is configured whereby upon receipt*
7 *of the request the personal communication device provides to the user a selection of*
8 *options of which at least one is to approve the request by selecting the relevant option*
9 (Khello, col. 8, lines 20-47; col. 9, lines 50-55). The combination of Khello and Tuneld
10 discloses that the personal communication device provides to the user the ability to
11 select one from a plurality of "secrets" (secret encryption algorithms) so as to uniquely
12 encode a PIN and then transmit the PIN to the user authentication center.

13
14 Regarding claim 26, the combination of Khello and Tuneld discloses:
15 *in which the memory stores a plurality of secrets and the personal*
16 *communication device is configured to provide a user with plurality of secrets from*
17 *which to select the secret to be provided to the digital device* (Khello, col. 8, lines 20-47;
18 col. 9, lines 50-55). The combination of Khello and Tuneld discloses that the personal
19 communication device provides to the user the ability to select one from a plurality of
20 "secrets" (secret encryption algorithms), stored in the device memory, so as to uniquely
21 encode a PIN and then transmit the PIN to the user authentication center.

22

1 Regarding claim 29, the combination of Khello and Tuneld discloses:
2 *in which the digital device is a non-cellular device* (Khello, fig. 1, elem. 20).

3

4 Regarding claim 30, the combination of Khello and Tuneld discloses:
5 *in which the digital device comprises a modem for communication with the*
6 *personal communication device* (Khello, fig. 1, elem. 18; fig. 4, elem. 48). The
7 combination of Khello and Tuneld discloses the digital device as comprising a
8 communication device for receiving telecommunications (a "modem") from the personal
9 communication device.

10

11 Regarding claim 31, it is rejected for the same reason as claim 17, and further
12 because the combination of Khello and Tuneld discloses:

13 *the personal communication device is configured to request confirmation from a*
14 *user that the secret can be provided and provides the secret to the digital device only if*
15 *the confirmation is provided by the user* (Khello, col. 6, lines 20-30). The secret is
16 provided only when the user initiates ("confirms") the transmission of the secret.

17

18 Regarding claim 32, it is rejected for the same reason as claims 17 and 25.

19

20 Regarding claims 1 – 10, 13 – 16, 33 – 42, and 45, and 46, they are the method
21 and apparatus claims corresponding to the system claims above, and they are rejected
22 for the same reasons.

1

2

3 **Claims 11, 12, 27, 28, 43, and 44 are rejected under 35 U.S.C. 103(a) as**
4 **being unpatentable over the combination of Khello and Tuneld in view of Hayashi**
5 **et al., "Connection of a Mobile Wireless Terminal to a Host Computer", GB**
6 **2,334,682 A.**

7

8 Regarding claims 27, the combination of Khello and Tuneld discloses using a
9 portable radiotelephone for authenticating a user to a remote system. The combination
10 of Khello and Tuneld does not disclose that the radiotelephone is a cellular
11 communication device.

12 Hayashi et al. discloses using a portable radiotelephone for authenticating a user
13 to a remote system. The portable radiotelephone of Hayashi et al. is a cellular
14 communication device (Hayashi et al., fig. 1; page 7, line 14 – page 8, line 3).

15 It would have been obvious to one of ordinary skill in the art to employ the
16 teaching of using cellular technology with portable radiotelephones of Hayashi et al. with
17 the portable radiotelephone system of the combination of Khello and Tuneld. This
18 would have been obvious because one of ordinary skill in the art would have been
19 motivated to enhance the service provided to radiotelephone users as cellular
20 technology would handle simultaneous connections on the same frequencies,
21 accommodate more subscribers than would a single central antenna, provide mobile

1 users with better reception via cell switching, as well as provide numerous other
2 benefits cellular technology has over the older central antenna radio systems.

3 Thus the combination of Khello, Tuneld and Hayashi et al., discloses:
4 *in which the personal communication device comprises a cellular communication*
5 *device* (Khello, fig. 1, elem. 12; Hayashi et al., fig. 1).

6

7 Regarding claim 28, the combination of Khello, Tuneld and Hayashi et al.,
8 discloses:

9 *in which the personal communication device comprises a cellular telephone for*
10 *voice calls* (Khello, col. 5, line 57 – col. 6, line 9).

11

12 Regarding claims 11, 12, 43, and 44, they are the method and apparatus claims
13 corresponding to the system claims above, and they are rejected for the same reasons.

14

15

16

Response to Arguments

17

18 Applicant's arguments with respect to claims 1 – 46 have been considered but
19 are moot in view of the new ground(s) of rejection.

20

1 **Conclusion**

2

3 The prior art made of record and not relied upon is considered pertinent to
4 applicant's disclosure.

5

6 **See Notice of References Cited**

7

8 A shortened statutory period for reply is set to expire 3 months (not less than 90
9 days) from the mailing date of this communication.

10 Any inquiry concerning this communication or earlier communications from the
11 examiner should be directed to Jeffery Williams whose telephone number is (571) 272-
12 7965. The examiner can normally be reached on 8:30-5:00.

13 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
14 supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone
15 number for the organization where this application or proceeding is assigned is (703)
16 872-9306.


1 Information regarding the status of an application may be obtained from the
2 Patent Application Information Retrieval (PAIR) system. Status information for
3 published applications may be obtained from either Private PAIR or Public PAIR.
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6 you have questions on access to the Private PAIR system, contact the Electronic
7 Business Center (EBC) at 866-217-9197 (toll-free).

8

9

10 Jeffery Williams
11 AU: 2137




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